

Remarks

Applicants have canceled claims 1-12 and 14-21 without prejudice or disclaimer, and amended the dependency of claim 13. New claims 22-57 have been added in order to claim additional embodiments of the subject matter of the provisionally-elected group. New claims 22-57 find support throughout the specification and claims as originally filed, and thus no new matter has been added.

Claims 13 and 22-57 are pending.

The Restriction Requirement

Pursuant to the Office Action mailed May 26, 2004, the Examiner has required an election under 35 U.S.C. § 121 of one of Groups I to VII. The Examiner has also required a further election under 35 U.S.C. § 121 of a single disclosed species from those listed in Table 1 (*i.e.*, Gene Nos. 1-3, corresponding to SEQ ID NOS:1-2, 3-4, and 5-6 and the respective deposited cDNA clones). The Examiner contends that the inventions of the Groups are distinct, each from the other.

In order to be fully responsive, Applicants provisionally elect, *with traverse*, the subject matter of Group II, directed to, *inter alia*, polypeptides, represented by original claims 11-12 and 16 (now canceled), and new claims 22-57. Applicants further provisionally elect, *with traverse*, the polypeptides of Gene 2, including but not limited to SEQ ID NO:4 and the polypeptide encoded by the HA5AA37 cDNA clone contained in ATCC Deposit No. PTA-1410. Applicants point out that claims 1-12 and 14-21 have been canceled without prejudice or disclaimer, and that new claims 22-57 are directed to subject matter falling within the ambit of Group II as cast by the Examiner.

With respect to the Examiner's restriction of groups directed to a nucleic acid sequence, polypeptides encoded thereby, antibodies recognizing such polypeptides, antagonists of such polypeptides, and methods of using the same, Applicants traverse. Even where patentably distinct inventions appear in a single application, restriction remains improper unless the examiner can show that the search and examination of these groups would entail a "serious burden". *See* M.P.E.P. § 803. In the present situation, although the Examiner has argued that Groups I-VII are separately classified or represent divergent subject matter, Applicants nonetheless submit that, with respect to a given gene, a search of the claims of the groups directed to that gene would also provide useful information for the claims of the other groups directed to that gene. For example, in many if not most publications disclosing a protein, the

authors also disclose nucleic acids encoding the protein, antibodies to the protein, and methods of making and using the same. Thus, since the searches for proteins, nucleic acids encoding such proteins, antibodies to such proteins, and methods of making and using the same commonly overlap, Applicants respectfully disagree with the Examiner's assertion that the combined search and examination of such compositions and methods using the same would entail a serious burden, even assuming *arguendo* that all of the searches were not coextensive.

Accordingly, in view of M.P.E.P. § 803, claims directed to the polypeptides of Gene 2 (including but not limited to SEQ ID NO:4 and the polypeptide encoded by the HA5AA37 cDNA clone contained in ATCC Deposit No. PTA-1410), polynucleotides encoding such polypeptides, antibodies that specifically bind to such polypeptides, and methods of making and using the same should be searched and examined in the present application. Applicants therefore respectfully request that the restriction requirement under 35 U.S.C. § 121 be reconsidered and withdrawn. Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

Conclusion

Entry of the above amendment is respectfully solicited. The Examiner is invited to call the undersigned at the phone number provided below if any further action by Applicants would expedite the examination of this application.

If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136, such an extension is requested and the appropriate fee should also be charged to our Deposit Account.

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Respectfully submitted,

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